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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,081	08/06/2003	Pramod K. Gupta	24866A	9824

28624 7590 02/08/2007  
WEYERHAEUSER COMPANY  
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FEDERAL WAY, WA 98063

EXAMINER
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PARA, ANNETTE H

ART UNIT	PAPER NUMBER
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1661

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/636,081

Applicant(s)

GUPTA ET AL.

Examiner

Annette H. Para

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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DETAILED ACTION

Status of the claims

Claims 1-21 are rejected. Claim 22 is cancelled.

It is acknowledged that applicant will provide a Terminal disclaimer upon allowance of the claim.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 1-18, and 20-21 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pullman et al. (US 5,294,549 published on March 15, 1994) for the reasons of record set forth in the office action mailed 10/3/05.

Applicants' arguments filed on November 17, 2006 have been fully considered, but they are not persuasive.

Applicants argue that the Pullman et al reference does not teach or suggest the invention as claimed.

Furthermore Applicants argue that the passages of Pullman et al. relied on by the Examiner fail to teach or suggest a medium comprising abscisic acid or gibberellin and an absorbent composition. Moreover Applicants argue that the medium described at Column 7, lines 24-28 does not include abscisic acid or gibberellin. Moreover, Applicants argue that the cited reference fails to teach the cultivation of embryos for a period of at least 0.5 week followed by transfer to a development medium as claimed (response page 6).

This not found persuasive because Pullman et al. teach a method of cultivation of early stage proembryos which are pre-cotyledonary conifer embryogenic cells (see specification p.3, lines 25-27) in a medium with a pH of 5.7 (column 13 table1) comprising 10.52 mg/L-15.85 mg/L of auxins, 7.92 mg/L- 16.5 mg/L of cytokinins in combination with 0.05- 1.0% activated charcoal (column 7, lines 24-28), for a period of a week and then transferred on a cotyledonary embryos development (column 19, example 6, lines 40-43, column 7, lines 29-31) .

In column 13, lines 49-51 and in column 8, lines 4-8 Pullman et al teach a medium with abscisic acid in combination with activated charcoal.

Further applicants argue that in Pullman et al. embryogenic callus is first placed on an induction culture medium, the early stage embryos are then transferred to a maintenance and multiplication followed by a transfer to a second maintenance medium then to a medium for singulation and finally to a development medium whereas, the

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present application is directed to method of cultivating pre-cotyledonary conifer embryogenic cells in a synchronization medium to produce pre-cotyledonary somatic embryos, which are then transferred to a development medium (response page 7).

This not found persuasive because it is noted that the claimed methods recite, "comprising" which leaves the claim open for the inclusion of other steps. See MPEP 2111.03.

Moreover, the specification on page 15, Table 2 describes the composition of media for different stage treatments used in example 1. These media are: induction medium, maintenance medium, synchronization medium, development medium, stratification medium, and germination medium as the media used by Pullman et al.

Claim Rejections - 35 USC § 103

Claim 19 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Pullman et al. (US Patent No. 5, 294, 549 1994) for the reason of record set forth in the office action mailed 10/03/2005.

Applicant's arguments filed on February 24, 2006 have been fully considered, but they are not persuasive.

Applicants argue that the examiner has failed to establish a *prima facie* case of obviousness because the cited reference fails to disclose or suggest all the claim elements of the claimed invention. Furthermore Applicants argue that the claimed invention is not rendered obvious in view of the teaching of Pullman et al. because there is no motivation or suggestion to modify the methods described in Pullman et al. to produce a synchronized population of conifer somatic embryos, as claimed (response pages 6-7).

This not found persuasive because the language "produce a synchronized population of conifer somatic embryos" does not result in manipulative difference in steps of claims; case does not present situation in which new use of process should be considered limiting because it distinguishes process over prior art.

In response to applicant's arguments, the recitation "produce a synchronized population of conifer somatic embryos" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the

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process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In considering the disclosure of a reference, it is proper to take in account not only specific teaching of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. See MPEP 2144.01

Pullman et al. teach that when the method for producing conifer somatic embryos is used to reproduce loblolly pine tree the osmotic level should be at least 200 mM/kg and preferably 240 mM/kg or even higher (column 7, lines 59-61). Moreover, Pullman et al. teach that these adjustments are considered to be within the routine experimental capability of those skilled in the art of tissue culture (column 13, lines 3-10). These teachings suggest all the claim elements of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

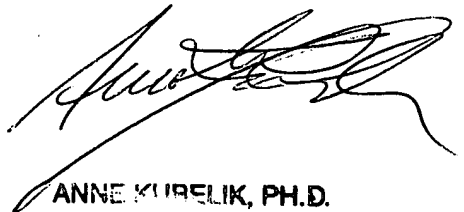
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about PAIR system, see <http://pair-direct.uspto.gov> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Annette H Para

1/25/2007



ANNE KURELIK, PH.D.  
PRIMARY EXAMINER